

Court of Justice EU, 16 February 2017,  
Brandconcern v Scooters India

**Lambretta**

#### TRADEMARK LAW

**General Court did not commit an error in law by granting Scooters India protection for all goods listed in the alphabetical list of class 12:**

- [the rule set out in the judgment CIPA v Registrar \(IPPT20120619\) on the interpretation of the application for registration is not applicable to the registration of trade marks which took place before the delivery of that judgment](#)

In that regard, it must be borne in mind that although, in paragraphs 21 to 24 of the judgment under appeal, the General Court examined the issue of the impact of [the judgment of 19 June 2012, Chartered Institute of Patent Attorneys \(C-307/10, EU:C:2012:361\)](#), and, in particular, paragraph 61 of that judgment, on the interpretation of the application for registration of the trade mark LAMBRETТА, it also found that the Court of Justice had not limited the temporal effects of that judgment.

In paragraph 61 of [the judgment of 19 June 2012, Chartered Institute of Patent Attorneys \(C-307/10, EU:C:2012:361\)](#), the Court of Justice thus took the view that, in order to respect the requirements of clarity and precision imposed by Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (OJ 2008 L 299, p. 25), the applicant for a national trade mark who uses all of the general indications listed in the heading of a particular class of the Nice Agreement in order to identify the goods and services for which the protection of the trade mark is sought must specify whether the application for registration is intended to cover all the goods or services included in the alphabetical list of the particular class concerned or only some of those goods or services. If the application relates to only some of those goods or services, the applicant will be required to specify which of the goods or services in that class are intended to be covered.

However, it is important to bear in mind, in the first place, that paragraph 61 of that judgment does not concern the proprietors of trade marks which have already been registered, but solely applicants for trade marks.

In the second place, in paragraph 61 of that [judgment of 19 June 2012, Chartered Institute of Patent Attorneys \(C-307/10, EU:C:2012:361\)](#), the Court of Justice limited itself to specifying the requirements to which new applicants for national trade marks remain subject, who use the general indications of a class in order to identify the goods and services for which protection as a trade mark is sought. Such requirements, as the Advocate General stated in [point](#)

[64](#) of his Opinion, help to prevent the situation in which it is not possible to determine with certainty the scope of the protection afforded by a trade mark when a trade mark applicant uses all the indications included in the heading of a class.

It cannot, therefore, be held that the Court of Justice, by [the judgment of 19 June 2012, Chartered Institute of Patent Attorneys \(C-307/10, EU:C:2012:361\)](#), sought to question the validity of the approach set out in Communication No 4/03 as regards trade marks registered before the delivery of that judgment. Consequently, the rule set out in paragraph 61 of that judgment is not applicable to the registration of the trade mark LAMBRETТА, which took place before the delivery of that judgment.

32. Consequently, by finding, in paragraph 35 of the judgment under appeal, that, according to the approach set out in Point V of Communication No 2/12, it was appropriate for the words “vehicles; apparatus for locomotion by land, air or water”, corresponding to the goods mentioned under the heading of Class 12 of the Nice Agreement, featuring in the application for the trade mark LAMBRETТА, to be interpreted as seeking to protect that trade mark for all the goods in the alphabetical list of Class 12, the General Court did not commit an error in law capable of justifying setting aside the judgment under appeal.

Source: [curia.europa.eu](http://curia.europa.eu)

#### Court of Justice EU, 17 February 2017

(J.L. da Cruz Vilaça (rapporteur), M. Berger, A. Borg Barthet, E. Levits and F. Biltgen)

JUDGMENT OF THE COURT (Fifth Chamber)

16 February 2017 (\*)

(Appeal — EU trade mark — Regulation (EC) No 207/2009 — Article 51(2) — Word mark LAMBRETТА — Genuine use of the mark — Application for revocation — Partial revocation — Communication No 2/12 of the President of EUIPO — Limitation of the temporal effects of a judgment of the Court)

In Case C-577/14 P,

APPEAL under Article 56 of the Statute of the Court of Justice of the European Union, brought on 10 December 2014,

Brandconcern BV, established in Amsterdam (Netherlands), represented by A. von Mühlendahl and H. Hartwig, Rechtsanwälte, and by G. Casucci, N. Ferretti and C. Galli, avvocati,  
appellant,

the other parties to the proceedings being:

European Union Intellectual Property Office (EUIPO),  
represented by J. Crespo Carrillo, acting as Agent,  
defendant at first instance,

Scooters India Ltd, established in Lucknow (India),  
represented by C. Wolfe, Solicitor, and by B. Brandreth and A. Edwards-Stuart, Barristers,  
applicant at first instance,

THE COURT (Fifth Chamber),

composed of J.L. da Cruz Vilaça (Rapporteur), President of the Chamber, M. Berger, A. Borg Barthet, E. Levits and F. Biltgen, Judges, Advocate General: M. Campos Sánchez-Bordona, Registrar: I. Illéssy, Administrator, having regard to the written procedure and further to the hearing on 11 May 2016, after hearing the [Opinion of the Advocate General](#) at the sitting on 19 July 2016, gives the following

### Judgment

1. By its appeal, Brandconcern BV seeks to have set aside the judgment of the General Court of the European Union of 30 September 2014, *Scooters India v OHIM — Brandconcern (LAMBRETTA)* (T-51/12, not published, “the judgment under appeal”, EU:T:2014:844), by which the General Court annulled the decision of the First Board of Appeal of the European Union Intellectual Property Office (EUIPO) of 1 December 2011 (Case R 2312/2010-1) relating to revocation proceedings between Brandconcern and Scooters India Ltd (“the contested decision”).

### Legal context

2. Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1), which entered into force on 13 April 2009, codified and repealed Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1).

3. Article 51 of Regulation No 207/2009, which corresponds to Article 50 of Regulation No 40/94, entitled “Grounds for revocation”, states:

*“1. The rights of the proprietor of the [EU] trade mark shall be declared to be revoked on application to [EUIPO] or on the basis of a counterclaim in infringement proceedings:*

*(a) if, within a continuous period of five years, the trade mark has not been put to genuine use in the [European Union] in connection with the goods or services in respect of which it is registered, and there are no proper reasons for non-use; however, no person may claim that the proprietor’s rights in a Community trade mark should be revoked where, during the interval between expiry of the five-year period and filing of the application or counterclaim, genuine use of the trade mark has been started or resumed; the commencement or resumption of use within a period of three months preceding the filing of the application or counterclaim which began at the earliest on expiry of the continuous period of five years of non-use shall, however, be disregarded where preparations for the commencement or resumption occur only after the proprietor becomes aware that the application or counterclaim may be filed;*

*[...]*

*2. Where the grounds for revocation of rights exist in respect of only some of the goods or services for which the [European Union] trade mark is registered, the rights of the proprietor shall be declared to be revoked in respect of those goods or services only.”*

4. By two communications, one published in 2003 and the other in 2012, the President of EUIPO provided guidance as regards the use of class headings of goods set out in the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended (“the Nice Agreement”).

5. The first paragraph of Point IV of Communication No 4/03 of the President of EUIPO, of 16 June 2003, concerning the use of class headings in lists of goods and services for Community trade mark applications and registrations (“Communication No 4/03”), stated:

*“The 34 classes for goods and the 11 classes for services comprise the totality of all goods and services. As a consequence of this the use of all the general indications listed in the class heading of a particular class constitutes a claim to all the goods or services falling within this particular class”.*

6. On 20 June 2012, the President of EUIPO adopted Communication No 2/12, repealing Communication No 4/03 and concerning the use of class headings in lists of goods and services for Community trade mark applications and registrations (“Communication No 2/12”). Point V of that Communication states:

*“As regards [EU] trade marks registered before the entry into force of the present Communication which use all the general indications listed in the class heading of a particular class, [EUIPO] considers that the intention of the applicant, in view of the contents of the previous Communication No 4/03, was to cover all the goods or services included in the alphabetical list of that class in the edition in force at the time when the filing was made.”*

### Background to the dispute and the contested decision

7. Scooters India is the proprietor of EU trade mark LAMBRETTA, which was applied for on 7 February 2000 and registered by EUIPO on 6 August 2002. The goods in respect of which that mark was registered are included, inter alia, in Class 12 of the Nice Agreement, corresponding to the following description: “vehicles; apparatus for locomotion by land, air or water”.

8. On 19 November 2007, Brandconcern filed an application for partial revocation of the trade mark LAMBRETTA under Article 50(1)(a) and (2) of Regulation No 40/94, now Article 51(1)(a) and (2) of Regulation No 207/2009, for the goods included, inter alia, in Class 12. In that regard, it pleaded lack of genuine use of that mark within a continuous period of five years.

9. On 24 September 2010, the Cancellation Division partially revoked the trade mark LAMBRETTA, with effect from 19 November 2007, in respect of the goods included, inter alia, in Class 12. On 23 November 2010, Scooters India filed a notice of appeal with EUIPO against the decision of the Cancellation Division.

10. By the contested decision, the First Board of Appeal of EUIPO, inter alia, rejected the appeal as regards the goods in Class 12 of the Nice Agreement. In that decision, the Board of Appeal, as regards the goods in that class, confined its examination of the

genuine use of the trade mark LAMBRETTA solely to “vehicles; apparatus for locomotion by land, air or water” in the literal sense of those terms. After finding that the evidence submitted by Scooters India in support of that genuine use was limited to evidence relating to the sale of spare parts for scooters and did not contain any evidence relating to the sale of “vehicles; apparatus for locomotion by land, air or water”, the Board of Appeal took the view that “it cannot be inferred from the sale of spare parts that [Scooters India] has also manufactured and sold ... any vehicle”.

#### **The procedure before the General Court and the judgment under appeal**

11. By application lodged at the Registry of the General Court on 8 February 2012, Scooters India brought an action seeking the annulment of the contested decision, relying on a single plea in law alleging infringement of Article 51(2) of Regulation No 207/2009. That plea consisted of two parts.

12. In the context of examining the first part of the single plea in law, the General Court, in paragraphs 35 to 38 of the judgment under appeal, found that the reference to “vehicles; apparatus for locomotion by land, air or water” in the Community trade mark application had to be interpreted as intended to protect the trade mark LAMBRETTA in respect of all the goods in the alphabetical list in Class 12 of the Nice Agreement. It also took the view that, even if “spare parts for scooters” did not actually appear in the alphabetical list of goods in Class 12, the Board of Appeal was required to examine whether there had been genuine use of that mark in respect of the many fittings and parts listed therein. Consequently, finding that the Board of Appeal had not examined the genuine use of that mark for those spare parts for scooters, the General Court upheld the first part of that plea and annulled the contested decision.

13. As regards the second part of the single plea in law, the General Court found, in paragraphs 42 to 44 of the judgment under appeal, that, as a result of the annulment of the contested decision as determined in the context of the first part, the Board of Appeal had to consider whether Scooters India had made use of the trade mark LAMBRETTA in respect of spare parts. The General Court took the view that the examination had to be made in accordance with the criteria set out by the Court of Justice in its [judgment of 11 March 2003, Ansul \(C-40/01, EU:C:2003:145](#), paragraphs 40 to 43).

#### **Forms of order sought by the parties before the Court of Justice**

14. Brandconcern claims that the Court should:

- set aside the judgment under appeal;
- dismiss the action by Scooters India seeking annulment of the contested decision;
- in the alternative, set aside the judgment under appeal in so far as it annulled the contested decision with regard to the goods “vehicles; apparatus for locomotion by land, air or water” in Class 12 of the Nice Agreement; and

– order EUIPO and Scooters India to bear the costs.

15. EUIPO contends that the Court should:

- dismiss the appeal as inadmissible;
- in the alternative, dismiss the appeal as being unfounded; and

– order Brandconcern to pay the costs.

16. Scooters India contends that the Court should:

- dismiss the appeal; and
- order Brandconcern to pay the costs.

#### **The appeal**

17. In support of its appeal, Brandconcern raises two grounds of appeal alleging, respectively, infringement of Article 51(1)(a), read in conjunction with Article 51(2), of Regulation No 207/2009, and a procedural error on the part of the General Court.

#### **The first ground of appeal**

##### **Arguments of the parties**

18. As a preliminary point, Brandconcern submits that Scooters India did not, before the General Court, dispute the finding by the Board of Appeal of EUIPO, in the contested decision, that the trade mark LAMBRETTA had not been used for the goods in respect of which it was registered, namely “vehicles; apparatus for locomotion by land, air or water” in Class 12 of the Nice Agreement. In those circumstances, and for that reason alone, the General Court should have dismissed Scooters India’s action. In any case, Brandconcern argues that the General Court should have declared the action brought by Scooters India inadmissible on the ground that the subject matter of that action was different from that of the appeal brought before the Board of Appeal. The appellant also states that Scooters India had raised the issue of the protection of the trade mark LAMBRETTA with regard to spare parts, as “individual components” of the goods in respect of which the trade mark is registered, only at the stage of the action before the General Court and not before EUIPO.

19. Next, Brandconcern submits that, with regard to the rule laid down by the Court of Justice in paragraph 61 of [the judgment of 19 June 2012, Chartered Institute of Patent Attorneys \(C-307/10, EU:C:2012:361\)](#), relating to the word sign “IP Translator”, the General Court erred in law in finding that the Board of Appeal of EUIPO had a duty to examine, by virtue of the principle of legal certainty, whether Scooters India had made genuine use of the trade mark LAMBRETTA for goods in respect of which it had not been registered. According to the appellant, the General Court erroneously held that, while Scooters India obtained registration of the trade mark LAMBRETTA for, pursuant to its application, “vehicles; apparatus for locomotion by land, air or water” in Class 12 of the Nice Agreement, Scooters India had to be granted the protection arising from the registration of that trade mark for any of the goods listed on the alphabetical list relating to that class.

20. In [the judgment of 19 June 2012, Chartered Institute of Patent Attorneys \(C-307/10, EU:C:2012:361\)](#), the Court of Justice held that, for reasons of clarity and precision, an application for

registration must state whether it is intended to cover all the goods or services included in the alphabetical list of the particular class concerned or only some of those goods or services. That application cannot be interpreted as designating all the goods in a particular class without a declaration by the trade mark applicant to that effect. Brandconcern argues that, contrary to what was found in the judgment under appeal, the case-law arising from that judgment should have been applied to the present case, taking account of the principle that a judgment delivered pursuant to Article 267 TFEU produces effects retroactively, notwithstanding the reasoning of legal certainty put forward by the General Court.

21. In any event, the requirements of clarity and precision with regard to the scope of registration cannot be met when account is taken of an alleged intention of the applicant of going beyond the literal meaning of the terms used in the registration, if such an intention is not established, as in the present case, in the declaration covering the goods listed in the alphabetical list of a particular class.

22. EUIPO and Scooters India submit that this ground of appeal must be rejected as unfounded.

#### **Findings of the Court**

23. With regard to the argument put forward in the first place by Brandconcern, it is sufficient to note that Scooters India requested, in its application before the General Court, annulment of the contested decision in that it rejected the action brought against the decision of the Cancellation Division of EUIPO revoking the trade mark LAMBRETTA for the goods in Class 12 of the Nice Agreement, including “parts and accessories for vehicles and apparatus for locomotion by land”.

24. In the same application, Scooters India submitted that those goods were simply a sub-category of “vehicles; apparatus for locomotion by land, air or water”, namely the goods under the heading of Class 12 mentioned in its application for registration, and not different goods. Therefore, Brandconcern cannot validly claim that Scooters India did not contest, before the General Court, the finding of the Board of Appeal of EUIPO, in the contested decision, that the trade mark LAMBRETTA had not been used for the goods in respect of which it was registered.

25. In those circumstances, that argument must be rejected as unfounded.

26. Brandconcern also complains that the General Court erred in law in so far as it limited the temporal effects of [the judgment of 19 June 2012, Chartered Institute of Patent Attorneys \(C-307/10, EU:C:2012:361\)](#). According to Brandconcern, that judgment is applicable in the present case in so far as it requires applications for registration of an EU trade mark, including those made before the delivery of that judgment, to be interpreted to the effect that only the goods expressly included in such applications are covered by the protection afforded by the EU trade mark.

27. In that regard, it must be borne in mind that although, in paragraphs 21 to 24 of the judgment under

appeal, the General Court examined the issue of the impact of [the judgment of 19 June 2012, Chartered Institute of Patent Attorneys \(C-307/10, EU:C:2012:361\)](#), and, in particular, paragraph 61 of that judgment, on the interpretation of the application for registration of the trade mark LAMBRETTA, it also found that the Court of Justice had not limited the temporal effects of that judgment.

28. In paragraph 61 of [the judgment of 19 June 2012, Chartered Institute of Patent Attorneys \(C-307/10, EU:C:2012:361\)](#), the Court of Justice thus took the view that, in order to respect the requirements of clarity and precision imposed by Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (OJ 2008 L 299, p. 25), the applicant for a national trade mark who uses all of the general indications listed in the heading of a particular class of the Nice Agreement in order to identify the goods and services for which the protection of the trade mark is sought must specify whether the application for registration is intended to cover all the goods or services included in the alphabetical list of the particular class concerned or only some of those goods or services. If the application relates to only some of those goods or services, the applicant will be required to specify which of the goods or services in that class are intended to be covered.

29. However, it is important to bear in mind, in the first place, that paragraph 61 of that judgment does not concern the proprietors of trade marks which have already been registered, but solely applicants for trade marks.

30. In the second place, in paragraph 61 of that [judgment of 19 June 2012, Chartered Institute of Patent Attorneys \(C-307/10, EU:C:2012:361\)](#), the Court of Justice limited itself to specifying the requirements to which new applicants for national trade marks remain subject, who use the general indications of a class in order to identify the goods and services for which protection as a trade mark is sought. Such requirements, as the Advocate General stated in [point 64](#) of his Opinion, help to prevent the situation in which it is not possible to determine with certainty the scope of the protection afforded by a trade mark when a trade mark applicant uses all the indications included in the heading of a class.

31. It cannot, therefore, be held that the Court of Justice, by [the judgment of 19 June 2012, Chartered Institute of Patent Attorneys \(C-307/10, EU:C:2012:361\)](#), sought to question the validity of the approach set out in Communication No 4/03 as regards trade marks registered before the delivery of that judgment. Consequently, the rule set out in paragraph 61 of that judgment is not applicable to the registration of the trade mark LAMBRETTA, which took place before the delivery of that judgment.

32. Consequently, by finding, in paragraph 35 of the judgment under appeal, that, according to the approach set out in Point V of Communication No 2/12, it was appropriate for the words “vehicles; apparatus for

locomotion by land, air or water”, corresponding to the goods mentioned under the heading of Class 12 of the Nice Agreement, featuring in the application for the trade mark LAMBRETTA, to be interpreted as seeking to protect that trade mark for all the goods in the alphabetical list of Class 12, the General Court did not commit an error in law capable of justifying setting aside the judgment under appeal.

33. Moreover, the interpretation of the contested application for registration adopted by the General Court is substantiated by the amendment introduced to Article 28(8) of Regulation No 207/2009 by Regulation (EU) No 2015/2424 of the European Parliament and of the Council of 16 December 2015 (OJ 2015 L 341, p. 21). The latter regulation inserted a transitional provision into that article, allowing the proprietors of EU trade marks applied for before 22 June 2012 and registered in respect of the entire heading of a class of the Nice Classification to declare, before 24 September 2016, that their intention, at the date when the application was lodged, was to apply for protection for goods and services other than those covered by the literal meaning of the heading but included in the alphabetical list for that class.

34. In those circumstances, the first ground of appeal must be rejected as unfounded.

#### **The second ground of appeal**

##### **Arguments of the parties**

35. By its second ground of appeal, raised in the alternative, Brandconcern argues that the judgment under appeal is vitiated by failure to state reasons, in that the General Court annulled the contested decision, whereas it found that Scooters India had not used the trade mark LAMBRETTA for the goods in respect of which it was registered, namely, “vehicles; apparatus for locomotion by land, air or water” under the heading of Class 12 of the Nice Agreement. In particular, there was a contradiction between, on the one hand, the reasons for that judgment examining the issue of the use of that trade mark for merely spare parts for scooters alone and, on the other hand, the operative part of that judgment annulling the contested decision as regards also the goods under the heading of Class 12 as well.

36. EUIPO submits that the second ground of appeal is inadmissible or, in any case, unfounded. For Scooters India, that ground of appeal must be rejected as unfounded.

##### **Findings of the Court**

37. The case-law of the Court of Justice clearly states that an appeal must indicate precisely the contested elements of the judgment which the appellant seeks to have set aside, and also the legal arguments specifically advanced in support of the appeal. The Court has also made it clear that a mere abstract statement of the grounds in the appeal does not satisfy the requirements set out in Article 58 of the Statute of the Court of Justice of the European Union and in Article 168(1)(d) of the Rules of Procedure of the Court of Justice. Furthermore, Article 169(2) of the Rules of Procedure specifies that the grounds of appeal and legal

arguments relied on must identify precisely those points in the grounds of the decision of the General Court which are contested. An appeal that does not have such characteristics cannot be the subject of a legal assessment which would allow the Court of Justice to exercise its function and to carry out its review of legality (judgment of 7 November 2013, *Wam Industriale v Commission*, C-560/12 P, not published, EU:C:2013:726, paragraphs 42 to 44).

38. In the present case, Brandconcern did not state, in its appeal, what the points of the judgment under appeal are in which the General Court ruled that Scooters India had not used the trade mark LAMBRETTA for the goods for which it was registered. Moreover, whilst it is true that Brandconcern, in its reply, refers to paragraphs 14, 16 and 17 of the judgment under appeal, it is not apparent from those paragraphs that the General Court took the view that Scooters India had not used the trade mark LAMBRETTA for the goods for which it was registered.

39. Contrary to Brandconcern’s assertions, the judgment under appeal concerns the issue relating to the interpretation of an application for registration and it makes no comment of any kind on the genuine use of the trade mark at issue for any of the goods in Class 12 of the Nice Agreement whatsoever.

40. In those circumstances, the second ground of appeal must be rejected as unfounded.

41. Since none of the grounds of appeal raised by Brandconcern has been upheld, the appeal must be dismissed in its entirety.

##### **Costs**

42. In accordance with Article 184(2) of the Rules of Procedure of the Court of Justice, where the appeal is unfounded, the Court is to make a decision as to the costs. Under Article 138(1) of those rules, which apply to the procedure on appeal by virtue of Article 184(1) thereof, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party’s pleadings.

43. Since EUIPO and Scooters India have applied for costs and Brandconcern has been unsuccessful, the latter must be ordered to pay the costs.

On those grounds, the Court (Fifth Chamber) hereby

1. Dismisses the appeal;
2. Orders Brandconcern BV to pay the costs.

Da Cruz Vilaça Berger Borg Barthet

Levits Biltgen

Delivered in open court in Luxembourg on 16 February 2017.

A. Calot Escobar J.L. da Cruz Vilaça

Registrar President of the Fifth Chamber

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#### **OPINION OF ADVOCATE GENERAL CAMPOS SÁNCHEZ-BORDONA**

delivered on 19 July 2016 (1)

Case C-577/14 P

Brandconcern BV

v

European Union Intellectual Property Office

(Appeal — European Union trade mark — Word mark “Lambretta” — Application for revocation filed by Brandconcern BV — Partial revocation)

1. One of the requirements for registration of a trade mark is that the goods or services in respect of which protection of that distinctive sign is sought must be identified in the application. For that purpose, economic operators, trade mark offices of the Member States and the European Union Intellectual Property Office (“the Office” or “EUIPO”) (2) use the Nice Classification. (3)

2. The Nice Agreement includes a list containing 34 classes of goods and 11 classes of services. Each class includes general indications corresponding to the sectors to which the goods or services concerned belong. The Classification also contains an alphabetical list of goods and services which states the class to which each of these belongs.

3. In the judgment in Chartered Institute of Patent Attorneys (4) (“IP Translator”), the Court ruled on the interpretation of use of the class headings in the Nice Agreement as a factor affecting the extent of the protection conferred by trade mark registration. The Court laid down a number of guidelines, in particular the need for trade mark applications to set out with clarity and precision the goods and services for which registration is sought. (5) However, the Court did not limit the temporal effects of the judgment.

4. In this appeal, Brandconcern BV seeks the annulment of the judgment of the General Court of 30 September 2014 in Scooters India v OHIM — Brandconcern (LAMBRETTA) (“the judgment under appeal”), (6) arguing that the General Court erred in failing to apply retroactively the case-law laid down in IP Translator to an application for registration filed with EUIPO in relation to class 12. Brandconcern BV’s appeal will allow, first, the case-law laid down in IP Translator to be outlined in general terms and, second, an analysis to be carried out of whether that case-law may be applied to marks which are already registered.

5. In any event, the significance of the judgment ruling on the appeal will be restricted in the light of the new version of Article 28 of Regulation No 207/2009, (7) following the entry into force, on 23 March 2016, of Regulation (EU) 2015/2424. (8) Article 28(8) seeks to mitigate the problems of interpretation concerning the classification of goods and services covered by trade marks registered before the date of the judgment in IP Translator.

### **I – Legislative framework**

#### **A – Regulation No 207/2009 on the European Union trade mark**

6. For the purposes of these proceedings, EU trade marks are governed by Regulation No 207/2009. Subsequent amendments pursuant to Regulation 2015/2424, which altered substantial aspects of the previous rules governing Community trade marks (now called “European Union trade marks”), (9) do not apply *ratione temporis* to this appeal. Nevertheless, it is appropriate to refer to the new Article 28 (“Designation

and classification of goods and services”), paragraph 8 of which provides:

*“8. Proprietors of EU trade marks applied for before 22 June 2012 which are registered in respect of the entire heading of a Nice class may declare that their intention on the date of filing had been to seek protection in respect of goods or services beyond those covered by the literal meaning of the heading of that class, provided that the goods or services so designated are included in the alphabetical list for that class in the edition of the Nice Classification in force at the date of filing.*

*The declaration shall be filed at the Office by 24 September 2016, and shall indicate, in a clear, precise and specific manner, the goods and services, other than those clearly covered by the literal meaning of the indications of the class heading, originally covered by the proprietor’s intention. [...]*

*EU trade marks for which no declaration is filed within the period referred to in the second subparagraph shall be deemed to extend, as from the expiry of that period, only to goods or services clearly covered by the literal meaning of the indications included in the heading of the relevant class.”*

7. Article 51, relating to grounds for revocation, is included in Title VI, “Surrender, revocation and invalidity”, and provides:

*“1. The rights of the proprietor of the Community trade mark shall be declared to be revoked on application to the Office or on the basis of a counterclaim in infringement proceedings:*

*(a) if, within a continuous period of five years, the trade mark has not been put to genuine use in the Community in connection with the goods or services in respect of which it is registered, and there are no proper reasons for non-use;*

*[...]*

*[...]*

*2. Where the grounds for revocation of rights exist in respect of only some of the goods or services for which the Community trade mark is registered, the rights of the proprietor shall be declared to be revoked in respect of those goods or services only.”*

#### **B – Implementing Regulation (EC) No 2868/95 (10)**

8. Under the heading “List of goods and services, Rule 2 provides:

*“1. The common classification referred to in Article 1 of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, shall be applied to the classification of the goods and services.*

*2. The list of goods and services shall be worded in such a way as to indicate clearly the nature of the goods and services and to allow each item to be classified in only one class of the Nice Classification.*

*3. The goods and services shall, in principle, be grouped according to the classes of the Nice classification, each group being preceded by the number of the class of that Classification to which that*

*group of goods or services belongs and presented in the order of the classes under that Classification.*

*4. The classification of goods and services shall serve exclusively administrative purposes. Therefore, goods and services may not be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification, and goods and services may not be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.”*

#### **C – Communications from the President of EUIPO**

9. The President of EUIPO exercises the powers granted to him under Article 124 of Regulation No 207/2009. In so far as is relevant for the present purposes, the most important of these is the power to adopt internal administrative instructions and, in particular, notices (paragraph 2(a)) which must be published in the EUIPO Official Journal in accordance with Article 89(b) of that regulation.

10. To explain the practice of the Office regarding the use of class headings and the consequences of such use when Community trade mark applications or registrations are restricted or partially surrendered or are involved in opposition or cancellation proceedings, the President adopted and published Communication No 4/03. (11) The first and second paragraphs of point IV of that communication are worded as follows:

*“The 34 classes for goods and the 11 classes for services comprise the totality of all goods and services. As a consequence of this the use of all the general indications listed in the class heading of a particular class constitutes a claim to all the goods or services falling within this particular class.*

*Similarly, the use of a particular general indication found in the class heading will embrace all of the goods or services falling under that general indication and properly classified in the same class. [...]”*

11. Following the judgment in IP Translator, and although in it the Court interpreted Directive 2008/95/EC (12) and not Regulation No 207/2009, the President of EUIPO published Communication No 2/12, (13) point V of which reads:

*“As regards Community trade marks registered before the entry into force of the present Communication which use all the general indications listed in the class heading of a particular class, the Office considers that the intention of the applicant, in view of the contents of the previous Communication 4/03, was to cover all the goods or services included in the alphabetical list of that class in the edition in force at the time when the filing was made.*

*The above is without prejudice to the application of Article 50 CTMR [Community Trade Mark Regulation].”*

#### **II – Background to the dispute**

12. It is apparent from paragraphs 1 to 6 of the judgment under appeal that Scooters India Ltd. is the proprietor of the Community word mark “Lambretta”, (14) which was applied for on 7 February 2000 and registered on 6 August 2002 under the number 1495100.

13. The application for registration limited to classes 3, 12, 14, 18 and 25 of the Nice Agreement the goods covered by the trade mark. For the purposes of this appeal, given that Scooters India partially withdrew its claims before the General Court, (15) it will suffice to refer to the goods belonging to class 12, described as follows in the Nice Agreement:

– Class 12: *“Vehicles; apparatus for locomotion by land, air or water”.*

14. On 19 November 2007, Brandconcern filed an application for partial revocation of the trade mark Lambretta, under Article 50(1)(a) and (2) of Regulation (EC) No 40/94. (16) That application for revocation covered, inter alia, the goods in class 12 and was based on the lack of genuine use of the mark for a continuous period of five years.

15 By decision of 24 September 2010, the Cancellation Division of EUIPO upheld Brandconcern’s claim and partially revoked the mark with effect from 19 November 2007 in respect of the goods included, inter alia, in class 12.

16. Scooters India appealed to EUIPO against the decision of 24 September 2010, under Articles 58 to 64 of Regulation No 207/2009.

17. By decision of 1 December 2011 (“the contested decision”), the First Board of Appeal of EUIPO dismissed the appeal brought by Scooters India, with the exception of the part relating to “soaps” in class 3 (in respect of which it annulled the decision of 24 December 2010). (17)

18. The Board of Appeal held, as a reason for dismissal of the appeal brought by Scooters India, that insufficient evidence had been provided of genuine use of the mark Lambretta in connection with the goods in class 12 (among others), which meant that the registration had to be revoked.

#### **III – The judgment under appeal**

19. By application of 8 February 2012, Scooters India lodged an action for annulment with the General Court against the decision of the Board of Appeal. That action was based on a single plea in law, alleging infringement of Article 51(2) of Regulation No 207/2009, which it divided into two complaints.

20. In the first complaint, Scooters India criticised the Board of Appeal for failing to exclude spare parts from the revocation of the trade mark, thereby claiming that EUIPO should have applied the criterion in force at the time when the application was lodged in 2000. According to that criterion, if an application for registration of a mark mentions, without distinction, the goods in a class heading, that application covers all the goods in the alphabetical list of goods and services covered by that class (“the all-embracing approach”).

21. The General Court analysed that complaint. It examined (18) whether spare parts for scooters were included in the goods listed in class 12 and then went on to examine whether the application for registration filed by Scooters India could be decided on the basis of the all-embracing approach or the “literal” approach, (19) that is by having regard solely to the meaning of the categories of goods explicitly set out in the class

heading concerned (in this case, vehicles and apparatus for locomotion by land, air or water).

22. The General Court referred to the judgment in *IP Translator*, (20) from which it follows that an applicant for a trade mark who uses all the general indications of a particular class heading of the Nice Classification must specify whether the application covers all the goods or services included in the alphabetical list of that class or only some of those goods or services and that, in the latter case, the applicant is required to specify which of the goods or services in that class are covered. (21)

23. Given that the judgment in *IP Translator* was delivered after the facts at issue in the proceedings, the General Court examined whether that judgment had any bearing on the case and held that Communication No 2/12 was applicable to the case, relying, essentially on the following arguments: a) Communication No 4/03 merely explained the practice of the Office up to the time of its publication; b) Communication No 2/12 did not distinguish between trade marks registered before and after Communication No 4/03; and c) the principle of legal certainty supported the application of Communication No 2/12 to trade marks, like *Lambretta*, which were registered before the adoption of Communication No 4/03. (22)

24. Accordingly, the General Court held that the fact that the application to register the trade mark *Lambretta* mentioned all the categories of goods in the heading of class 12 must be interpreted as meaning that it covered all the goods in the alphabetical list for that class, which, moreover was the intention of Scooters India. The General Court also observed that, even though “spare parts for scooters” do not actually appear in the alphabetical list of goods in class 12, that list includes fittings and parts for vehicles, such as tyres, wheels and crankcases, and therefore the Board of Appeal should have examined whether there had been genuine use of the mark in respect of spare parts. Since no such examination was carried out in the contested decision, the General Court upheld the first complaint in the plea for annulment put forward by Scooters India. (23)

25. In the second complaint, Scooters India complained that the Board of Appeal erred in law by not applying the case-law of the Court of Justice according to which the actual use of a mark in connection with parts preserves the rights of the proprietor of that mark in relation to the goods of which those parts are an integral part. (24)

26. The General Court dismissed the second complaint because the Board of Appeal had not examined the evidence adduced in relation to spare parts for scooters. However, it instructed the Board of Appeal about how it should carry out that examination regarding the use of the trade mark *Lambretta* for spare parts, referring, *inter alia*, to the criteria laid down in *Ansul*. (25)

#### **IV – Procedure before the Court and forms of order sought by the parties**

27. The appeal lodged by Brandconcern was received at the Court Registry on 11 December 2014; the

defences of EUIPO and Scooters India were received on 10 March 2015 and 18 March 2015 respectively.

28. In accordance with Article 175(1) of the Rules of Procedure of the Court of Justice, the reply was lodged on 4 June 2015 and the rejoinders of Scooters India and EUIPO were lodged on 8 and 13 July 2015 respectively.

29. Brandconcern primarily claims that the Court should: a) annul the judgment under appeal; b) dismiss the appeal by Scooters India before the General Court; and c) order the opposing parties to pay the costs. In the alternative, Brandconcern claims that the judgment under appeal should be annulled to the extent that it quashed the decision of the Board of Appeal of 1 December 2011 and that EUIPO and Scooters India should be ordered to bear the costs.

30. EUIPO claims that the Court should: a) declare that the second ground of appeal is inadmissible; b) dismiss the appeal; and c) order Brandconcern to pay the costs.

31. Scooters India claims that the Court should dismiss the appeal and order Brandconcern to pay the costs.

32. At the request of Brandconcern and Scooters India under Article 76(1) of the Rules of Procedure, a hearing was held on 11 May 2016 at which all the parties presented oral argument.

#### **V – Examination of the appeal**

33. Brandconcern alleges that the General Court committed two errors of law: a) infringement of Article 51(1)(a), in conjunction with Article 51(2), of Regulation No 207/2009, and b) a procedural defect consisting of inconsistency between the forms of order sought by the appellant and the operative part of the judgment, as a result of which the General Court ruled *ultra petita*.

#### **A – The first ground, alleging infringement of Article 51(1)(a), in conjunction with Article 51(2), of Regulation No 207/2009**

##### **1. Arguments of the parties**

34. Brandconcern submits (26) that the General Court erred in law by holding that EUIPO had a duty, in accordance with the principle of legal certainty, to examine whether Scooters India had put the trade mark to genuine use in relation to spare parts, after accepting that the registration of that sign, based on the wording of class 12, also covered those goods.

35. Brandconcern relies in support of its contention on the judgment in *IP Translator*, in which the Court of Justice ruled in favour of the literal interpretation of the wording used by trade mark proprietors in their applications for registration. According to Brandconcern, that judgment should be applied unconditionally to this case and without precedence being given to the considerations relating to legal certainty set out by the General Court in the judgment under appeal.

36. Brandconcern contends that the General Court cannot limit the temporal effects of a judgment of the Court of Justice where the latter did not lay down such a reservation in its own decision. Moreover, Scooters India did not put forward before the General Court any precedent to support such a relaxation of the principle



of legal certainty, and the judgment under appeal does not do so either. In that connection, the General Court may not rely on its own judgments to limit the effects of a judgment of the Court of Justice.

37. Lastly, Brandconcern denies that the interpretation of a trade mark application must take account of the intention of the trade mark proprietor, (27) contrary to the practice of EUIPO prior to Communication No 2/12. In any event, that intention must relate to the list of goods and services in order to determine, with the highest degree of accuracy, the extent of the protection claimed by the trade mark proprietor, as the judgment in IP Translator subsequently stipulated. It is not possible to make up for shortcomings in the original declaration by having recourse to a subsequent claim of seniority or to appeal proceedings.

38. In short, in Brandconcern's submission, the Court could have adopted a "forward-looking" approach in IP Translator as a guideline for interpretation of trade mark applications, but it did not do so. Rather, the Court laid down a general rule, calling for clarity and precision in the indications included in trade mark applications, in the light of which such applications must be interpreted.

39. EUIPO rejects the arguments of Brandconcern. In particular, EUIPO contends that the IP Translator judgment did not opt for either of the two approaches, that is the all-embracing approach of Communication No 4/03 or the literal approach. EUIPO observes that that judgment dealt with trade mark applications and not trade marks which are already registered, from which it follows that the requirements of clarity and precision relate above all to the former and not in the same way to the latter.

40. According to the Office, paragraph 60 of the IP Translator judgment indicates that the applicant's intention is the essential criterion for determining the extent of the protection inherent in a trade mark. Whilst it is for applicants to disclose their intention by fulfilling the requirements of clarity and precision, the competent authorities (trade mark offices) must ascertain that intention in relation to trade marks already registered. The IP Translator judgment cannot be relied on against the clarification of the applicant's intention by means of a presumption. In that connection the General Court did not ignore the guidance in the IP Translator judgment regarding trade mark applications but simply moderated them in relation to registered trade marks.

41. The Office further observes that the intention of Scooters India was evident when it applied to register the earlier UK trade mark Lambretta, in which it claimed seniority for all the goods, including for "motor cars, motor vans and cycles; and parts and fittings therefor".

42. Scooters India submits that the interpretation of the IP Translator judgment in the manner proposed by Brandconcern would infringe the principles of legal certainty and the protection of the legitimate expectations of operators who relied on the approach of trade marks offices (not just of EUIPO) regarding the

designation of a class heading as shorthand to refer to all the goods belonging to that class according to the alphabetical list. Scooters India further submits, based on the same arguments as EUIPO, that Brandconcern has wrongly interpreted the IP Translator judgment.

## **2. Examination of the ground of appeal**

43. By its first ground of appeal, Brandconcern submits that the judgment under appeal infringes Article 51(1)(a), in conjunction with Article 51(2), of Regulation No 207/2009. That provision provides that the trade mark must have been put to genuine use for a period of five years in connection with the goods and services which it covers. (28)

44. Whilst the expression "genuine use" was given an extensive and detailed interpretation in the judgment in Ansul (29) and is not at issue in this appeal, an interpretation is still required of the reference to "goods or services in respect of which [the trade mark] is registered".

45. Since, under Article 26(1)(c) of Regulation No 207/2009, for a sign to be eligible for registration, the EU trade mark application must set out the goods or services for which protection is sought, Brandconcern claims that the assessment of that application must be carried out in accordance with the criteria laid down in the IP Translator judgment.

46. There are two lines of disagreement surrounding the application of the IP Translator judgment to this case: whether that judgment is relevant *ratione temporis* and whether it is applicable from a substantive point of view. Whilst Brandconcern argues that the judgment itself does not limit its effects and that, consequently, the General Court was not entitled to moderate the application of the judgment on the grounds of legal certainty, EUIPO draws attention to the difference between the subject matter of the two disputes: a trade mark application (in IP Translator) and a registered trade mark (in these proceedings).

### **a) The temporal limitation of the effects of judgments given by the Court of Justice**

47. It is settled case-law that the interpretation of a provision of EU law, adopted by the Court in the exercise of the jurisdiction conferred on it by Article 267 TFEU, clarifies and defines the meaning and scope of that rule as it must be or ought to have been understood and applied from the time of its entry into force. It follows that the rule as thus interpreted may, and must, be applied even to legal relationships which arose and were established before the judgment ruling on the request for interpretation, provided that in other respects the conditions for bringing a dispute relating to the application of that rule before the competent courts are satisfied. (30)

48. That same case-law stipulates that, in accordance with the general principle of legal certainty inherent in the European Union legal order, the Court may only restrict the opportunity to rely on a provision by way of exception, when the criteria that those concerned should have acted in good faith and that there should be a risk of serious difficulties are fulfilled. (31)

49. Finally, according to that case-law, it is for the Court to determine a single point from which the interpretation which it has given to a provision of EU law is to take effect, and restricting the temporal effects of such an interpretation may be allowed only in the actual judgment. This guarantees the equal treatment of the Member States and of other persons subject to EU law, under that law, fulfilling, at the same time, the requirements arising from the principle of legal certainty. (32)

50. In short, the case-law on the limitation of the effects of a judgment of the Court of Justice may be summarised in the following points: a) in principle, the judgments of the Court produce effects *ex tunc*; b) the effects of the interpretation of a provision may be limited only by way of exception; c) the Court alone has jurisdiction to adopt such a limitation; and d) that limitation must be expressly stipulated in the judgment interpreting the provision concerned.

51. It is true that, as Brandconcern points out, the IP Translator judgment does not stipulate any temporal limitation of its effects, from which it follows that, at first sight, the provision interpreted must be applied also to legal situations established before the judgment. However, it is striking that none of the parties to those preliminary-ruling proceedings (11 Member States, the Commission, EUIPO and the two litigants in the main proceedings) requested such a limitation, which would have required the Court to grant or refuse that request, but the judgment is silent in that regard. Although there is room for conjecture as to the reasons for that silence, I prefer not to enter terrain which is merely speculative and, therefore, of little benefit to these proceedings.

52. However, it is more helpful to examine the argument of the Office which, in support of the judgment of the General Court, qualifies the effects of the IP Translator judgment on these proceedings: whereas that case was concerned with a trade mark application, this case is concerned with a trade mark which is already registered. Accordingly, it is necessary to ascertain what, in fact, that judgment means.

#### **b) The IP Translator judgment**

53. The case concerned (33) an application to register the designation “IP Translator” as a national trade mark. The application identified the services covered using the general wording of the heading of Class 41 of the Nice Classification, that is to say, “Education; providing of training; entertainment; sporting and cultural activities”.

54. The United Kingdom Registrar of Trade Marks refused the application on the basis of the national provisions corresponding to Article 3(1)(b) and (c) and (3) of Directive 2008/95. The Registrar interpreted that application in accordance with Communication No 4/03 (34) as meaning that it covered not only services of the kind specified by the applicant but also every other service falling within Class 41 of the Nice Classification, including translation services. The Registrar concluded that, for these latter services, the designation “IP Translator” lacked distinctive character and was descriptive in nature.

55. The trade mark applicant (35) appealed against that decision, contending that its application did not specify, and therefore did not cover, translation services in Class 41. For that reason, it submitted, the Registrar’s objections to registration were misconceived and its application had been wrongly refused.

56. In its reply to the three questions referred for a preliminary ruling (as reformulated), the Court:

– imposed on trade mark applicants the obligation to identify with sufficient clarity and precision the goods and services in respect of which trade mark protection is sought; (36)

– allowed the use by the applicant of the general indications of the class headings of the Nice Classification, provided that such identification is, of itself, sufficiently clear and precise; (37) and

– in that situation (where an applicant uses all the general indications of a specific class heading), the Court stipulated that the trade mark applicant has a duty to specify whether it claims protection for all the goods or services included in the alphabetical list of the particular class concerned or only some of those goods or services. (38)

57. From a reading of the IP Translator judgment, I conclude, first, that the operative part of that judgment must be understood in the context of the dispute which it resolved, relating to the refusal of a trade mark application based on the interpretation of the class of services for which protection was claimed. In particular, the judgment describes the way in which a trade mark applicant must fulfil the obligation to state with clarity and precision the list of goods or services for which registration of the sign claimed is sought. (39)

58. Second, although the third question referred reflected the dispute between supporters of the literal approach and supporters of the all-embracing approach (40) and invited the Court to intervene in that debate, the Court politely declined that invitation, focusing in its reply on the application and referring the problem back to the jurisdiction of trade mark offices. (41)

59. It may be inferred from the judgment that the Court did not actually support either of the options at issue. Moreover, the Court went as far as to agree that it was possible to refer to the classes generically and stipulated only that there must be sufficient clarity and precision whatever method of interpretation is used. Admittedly, such a solution concerns to a greater extent systems governed by the all-encompassing approach since, according to that solution, an applicant must specify whether its application is intended to cover all the goods or services included in the alphabetical list of each class which it mentions or only some of goods or services included in that list. (42) However, I repeat, the operative part of the judgment unequivocally declared that the use of the general indications is not precluded.

60. Third, albeit perhaps less relevantly, the IP Translator judgment did not interpret a particular provision of Directive 2008/95 but rather deduced the obligation of clarity and precision imposed on trade

mark applicants from all the articles and recitals of that legislative text. (43)

**c) Applicability to the instant case**

61. Is it possible simply to apply the IP Translator judgment to the situation which gave rise to these proceedings? I share the reservations of EUIPO in this respect, for the reasons which I shall now set out.

62. As I have pointed out, the IP Translator case arose in the context of an application to register a distinctive sign which was intended to protect certain services. In relation to that stage of the trade mark registration procedure, the Court imposed on the applicant the requirement of clarity and precision in order to make it easier to apply other articles of the relevant regulation, such as those relating to the absolute and relative grounds for refusal, which may also, at a later stage, be relied on as grounds for invalidity of the trade mark. (44)

63. That requirement (45) fundamentally concerns the applicant. In IP Translator, the requirements imposed on trade mark offices are more tenuous and the references to those national bodies (“the competent authorities”) are intended either to draw attention to the relationship between the requirement of clarity and precision in applications and fulfilment of the obligations of trade mark offices relating to the prior examination of applications, (46) or to remind trade mark offices, in the same vein, of their responsibility to make an assessment on a case-by-case basis in order to determine whether the general indications of the class headings meet the requirements of clarity and precision. (47) However, those requirements are not reflected in the operative part of the judgment.

64. In that context, paragraph 60 of the judgment, (48) which appears to invalidate the EUIPO practice set out in Communication No 4/03 (based on the all-encompassing approach), acquires a meaning which is more in keeping with the rest of the judgment. Read in conjunction with paragraph 61, the criticism reveals its true extent, which is the warning that such conduct jeopardises the requirement of clarity and precision imposed on trade mark applicants. If there were no such requirement, when all the indications of a class heading are used, neither the applicant nor third party operators would know with certainty the extent of the protection derived from the use of the general indications.

65. The risk of using the all-encompassing approach or criterion is that applicants fail to fulfil their obligation to state clearly the goods and services for which they seek protection. It is therefore necessary to ensure that the applicant’s obligation is not replaced by a lax administrative practice. However, in the context of the judgment, that aim must be construed as a warning not to accept, at the prior examination stage, applications which, because of their vagueness, do not comply with the requirement of clarity and precision in the identification of the goods and services covered. I believe that this is the meaning of paragraph 62 of the IP Translator judgment.

66. In my opinion, the difference between the underlying facts of IP Translator and this case (in the former, the facts concerned a trade mark application; in this case, they concern a registered trade mark) precludes the application of the findings and criteria laid down in that judgment, which leads to the dismissal of Brandconcern’s first ground of appeal.

67. That outcome is hardly surprising in view of the fact that the trade mark application is filed at a stage of the trade mark registration procedure in which it is still possible to correct or amend the application, as is clear from Article 43 of Regulation No 207/2009. The IP Translator judgment bolsters the obligation of national offices, in relation to that stage of their examination, to ensure that the examination of applications is stringent and full, in order to prevent trade marks from being improperly registered. (49) Since their task is to maintain an appropriate and precise register, (50) it seems logical that the judgment in IP Translator should compel them, indirectly, to ensure that economic operators file applications which comply with the requirement of clarity and precision.

68. However, once a trade mark has been registered, the interpretation of the list of goods and services which it protects is covered by another type of rule, including, inter alia, the prohibition of the alteration of the trade mark laid down in Article 48 of Regulation No 207/2009. The findings made in IP Translator are not easily reconciled with the role of trade mark offices at this other stage. It is precisely the difference between the two stages which explains the absence of any limitation of the effects of the IP Translator judgment: the interpretation of the list of goods and services contained in an application, which may still be amended, is not the same as the interpretation of the list of goods and services covered by a trade mark which is already registered and which is, by definition, established and almost unchangeable.

**d) Corollary**

69. Accepting as correct the argument put forward by the Office concerning the bearing of the IP Translator judgment on the interpretation of the list of goods and services covered by registered trade marks, the main argument advanced by Brandconcern in support of its first ground of appeal must fail since that judgment deals with the obligations of an economic operator who files a trade mark application.

70. The appellant’s complaint is, in fact, based on an inadequate reading of the judgment under appeal, for that judgment does not limit the temporal effects of the IP Translator judgment, notwithstanding the reference, in paragraph 24 of the judgment under appeal, to the settled case-law on this subject and to the fact that IP Translator did not include any reference to temporal effects. The General Court simply examined whether the Office was entitled to apply Communication No 4/03 to a trade mark registered before 21 June 2012, which would entail the use of the all-encompassing approach to determine whether spare parts are included in class 12, even though they are not expressly referred to. That examination was the necessary prerequisite for

establishing whether the Board of Appeal should have examined the evidence adduced by Scooters India in relation to genuine use of the trade mark for those parts.

71. In that context, the judgment under appeal examined (51) Communication No 2/12, which it classified as applying the principle of legal certainty in a situation in which EUIPO was required to explain how it intended to determine the extent of the protection conferred by EU trade marks registered before 21 June 2012 which used the general indications of the class headings in the Nice Agreement.

72. Later, in paragraphs 28 to 34, the judgment under appeal rejected the reasoning that Scooters India could not rely on the principle of legitimate expectations because Communication No 4/03 was published after it filed its application. The General Court held that that communication explained and consolidated the practice followed until that time by EUIPO. Therefore, the communication should also be applied to the interpretation of the list of goods in respect of which Scooters India registered the Lambretta trade mark in 2002.

73. It may be deduced from the foregoing that the judgment under appeal adopts the criterion of separation of trade marks applied for and trade marks which are already protected, without thereby seeking to limit the temporal effects of the IP Translator judgment. In view of the interpretation of the IP Translator judgment proposed under heading b) of the examination of this first ground of appeal, the General Court cannot be accused of breaching the criteria laid down in that judgment.

74. EUIPO could therefore have applied the all-encompassing approach for reasons of legal certainty, a principle inherent in the EU legal order, and examined the intentions of Scooters India when it filed the application. The General Court did not err in law in holding that the Office could use the all-encompassing approach for trade marks registered before 21 June 2012 or in requiring the Board of Appeal to examine whether Scooters India had put the Lambretta trade mark to genuine use in relation to spare parts.

75. I shall, if I may, make one last point: by inserting the new Article 28(8) into Regulation No 207/2009, (52) the EU legislature sought to mitigate the deficiencies in the system by allowing the proprietors of trade marks registered before 22 June 2012 to clarify, by 24 September 2016, their intention on the date of filing in relation to the goods or services mentioned in the heading of the class concerned. That provision therefore offers such proprietors the opportunity to rely on the all-embracing approach in order to dispel any uncertainties regarding the substantive scope of protection (goods and services) of their intellectual property rights. Apart from the fact that one instrument has legislative force and the other does not, the aim is the same as that sought by the Office by means of Communication No 2/12.

76. Accordingly, it would be paradoxical to annul the judgment of the General Court — as Brandconcern

seeks — which adopts the same approach as the legislature, when Scooters India is still able to “clarify its intention” to EUIPO in order to confirm it is the same as that identified by the General Court. Moreover, it should be noted that the legislature has also complied with the IP Translator judgment in restricting its intervention to trade marks which were registered before the judgment was delivered.

77. In short, since the infringement of Article 51(1)(a), in conjunction with Article 51(2), of Regulation No 207/2009, has not been established, Brandconcern’s first ground of appeal should be dismissed.

**B – The second ground of appeal, alleging infringement of the obligation to state reasons because of a lack of consistency**

78. The dismissal of the first ground of appeal means that it is necessary to examine the second ground, which Brandconcern put forward in the alternative.

**1. Arguments of the parties**

79. Brandconcern submits that the judgment under appeal is vitiated by a “procedural defect” (53) which renders the decision ultra petita, (54) for the General Court would have annulled the contested decision despite a finding that Scooters India had not used the trade mark for the goods in the heading of class 12. Brandconcern contends that the judgment under appeal should have confirmed the contested decision with regard to “vehicles; apparatus for locomotion by land, air or water” and annulled that decision solely to the extent that it did not examine the use of the mark in relation to other goods in class 12, namely, spare parts.

80. EUIPO submits, first, that this ground is inadmissible because Brandconcern has not indicated the paragraphs of the judgment under appeal which state that the Lambretta trade mark has not been put to genuine use for vehicles or the apparatus for locomotion referred to. Since that company has not indicated the legal basis for the ground of appeal either, EUIPO contends that the requirements for admissibility of the appeal laid down in Articles 21 and 53(1) of the Statute of the Court of Justice are not satisfied.

81. As concerns the substance, the Office submits that the General Court correctly annulled the contested decision and duly remitted it to the Board of Appeal for examination of the evidence of genuine use of the mark in relation to a subcategory of goods.

82. Scooters India submits, in line with EUIPO, that the second error of law does not exist and that there is no real difference between it and the first.

**2. Examination of the ground of appeal**

**a) Is the ground of appeal inadmissible?**

83. Contrary to the Office’s contention, I believe that the essential elements laid down in Article 21, in conjunction with Article 53(1), of the Statute of the Court and implemented in Article 168 of the Rules of Procedure of the Court are met. Even though those elements have not been set out with complete clarity and the type of procedural defect by which the judgment is vitiated has not been specifically stated either, I believe that Brandconcern’s complaint is, at least, admissible to the extent that it claims that the

General Court went further in its decision than the forms of order sought by the applicant.

84. The reasoning in this second ground of appeal is that, since the proceedings before the General Court were concerned solely with spare parts (and the use of the trade mark in relation to such parts), it could reasonably be deduced, in Brandconcern's submission, that EUIPO's findings relating to proof of genuine use of the mark for vehicles and apparatus for locomotion were not covered by the annulment, which should have precluded the judgment under appeal from quashing the whole of the contested decision.

85. That criticism amounts to a complaint of inconsistency on the part of the General Court which, it is alleged, ruled *ultra petita*, (55) which means that the second ground of appeal is admissible.

#### **b) The substance**

86. To my mind, the second ground of appeal cannot be upheld either because the General Court did not commit the procedural defect alleged against it.

87. Scooters India claimed that the General Court should "annul the contested decision in so far as the Board of Appeal dismissed the applicant's appeal in relation to the goods in Class 12", (56) without making any distinction in that regard. The General Court did not rule *ultra petita* in the judgment by granting that form of order as formulated.

88. Further, paragraph 44 of the judgment, to which the second ground of appeal refers, is not part of the *ratio decidendi* of the judgment and, therefore, has no significant bearing on the operative part. The legal grounds which led to the annulment of the contested decision are found in an earlier section of the judgment. (57) At paragraph 44 of the judgment, the General Court confines itself to explaining, almost pedagogically, to the Board of Appeal the type of examination "it will be necessary" to carry out. Similarly, paragraph 43, in which the General Court also orders the General Appeal to be guided by the case-law laid down in *Ansul*, (58) adds to that didactic tone.

89. Under Article 266 TFEU, it is for the institution whose act has been declared void "to take the necessary measures to comply with the judgment". To that end, it will be necessary to have regard not only to the operative part of the judgment but also to the grounds leading up to it, which constitute its essential basis, in that they are necessary to establish the precise meaning of what was determined by the operative part. It is those grounds which, on the one hand, identify the precise provision held to be illegal and, on the other, indicate the specific reasons which underlie the finding of illegality which the institution concerned must take into account when replacing the annulled measure. (59)

90. Accordingly, the General Court is not required to indicate to the institution concerned what measures it must adopt, (60) which does not preclude it from providing that institution with certain guidelines regarding how to proceed. However, in that situation, as occurs in paragraph 44 of the judgment, those guidelines are of merely educative value.

91. Moreover, it is important to refer to the settled case-law of the Court to the effect that the procedure for replacing such an annulled measure may be resumed at the very point at which the illegality occurred and that annulment of a Community measure does not necessarily affect the preparatory acts, (61) from which it follows that the Board of Appeal would be perfectly entitled to accept the evidence adduced in relation to the goods in the heading of class 12, should it consider that appropriate.

92. In the light of the foregoing considerations, the second ground of appeal should be dismissed.

#### **VI – Costs**

93. Under Articles 138(1) and Article 184(1) of the Rules of Procedure of the Court of Justice, the unsuccessful party in the appeal is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Since I have proposed that the Court should dismiss the appeal, and since an application to that effect was made by EUIPO and Scooters India, Brandconcern must bear the costs incurred by the two respondents.

#### **VII – Conclusion**

94. In the light of the foregoing considerations, I propose that the Court should:

- (1) dismiss the appeal brought by Brandconcern BV against the judgment of the General Court of 30 September 2014 in Case T-51/12, *Scooters India v OHIM — Brandconcern (LAMBRETTA)*;
- (2) order Brandconcern BV to bear the costs of the European Union Intellectual Property Office and Scooters India Ltd.

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1 – Original language: Spanish.

2 – The initials of its name in English (European Union Intellectual Property Office) are used to designate the Office in all the other languages.

3 – Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as amended on 28 September 1979) (United Nations Treaty Series Vol. 1154, No I-18200, p. 89; "the Nice Classification", "the Agreement" or simply "the Classification").

4 – Judgment in *Chartered Institute of Patent Attorneys (C-307/10, EU:C:2012:361)*. The case is known by the name of the word sign with which it dealt: "IP Translator".

5 – On the judgment in *IP Translator*, see point 53 et seq.

6 – *Scooters India v OHIM (T-51/12, EU:T:2014:844)* (not published).

7 – Council Regulation of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1).

8 – Regulation of the European Parliament and of the Council of 16 December 2015 amending Council Regulation (EC) No 207/2009 on the Community trade mark and Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on

the Community trade mark, and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OJ 2015 L 341, p. 21).

9 – Or also “EU trade mark”, in accordance with Article 1(2) of Regulation 2015/2424. I shall use the terms “European Union trade mark” and “EU trade mark” interchangeably.

10 – Commission Regulation of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark (OJ 1995 L 303, p. 1), as amended by Commission Regulation (EC) No 355/2009 of 31 March 2009 (OJ 2009 L 109, p. 3) (“the Implementing Regulation”).

11 – Communication No 4/03 of the President of the Office of 16 June 2003 concerning the use of class headings in lists of goods and services for Community trade mark applications and registrations.

12 – Directive of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (OJ 2008 L 299, p. 25).

13 – Communication No 2/12 of the President of EUIPO of 20 June 2012, which has an identical heading to its predecessor, Communication No 4/03, which it repealed and replaced. Communication No 2/12 will be repealed in stages: one part with effect from 23 March 2016 and the rest with effect from 25 September 2016, when it will be replaced by Communication No 1/2016 of the President of the Office of 8 February 2016 concerning the implementation of Article 28 EUTMR [European Union Trade Mark Regulation].

14 – In its defence, Scooters India states that the application claimed seniority for five trade marks registered in the United Kingdom, in particular No 874581 for motor cars, motor vans and cycles, and parts and fittings therefor included in class 12, and one trade mark registered in Italy.

15 – According to paragraph 7 of the judgment under appeal, Scooters India withdrew its claim for annulment in relation to the other classes of goods and services.

16 – Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1). Now Article 51(1)(a) and (2) of Regulation No 207/2009.

17 – On the same date, the Board of Appeal also dismissed an appeal by Brandconcern against the decision of the Cancellation Division.

18 – Paragraph 18 et seq. of the judgment under appeal.

19 – When referring to those two approaches, the English terms “class-heading-covers-all-approach”, for the all-embracing approach, and “class-heading-means-what-it-says-approach”, for the literal approach, are frequently used. See, for example, Kramer, F., “§32”, in Ekey/Bender/Fuchs-Wisseman (directors), *Markenrecht*, (vol. I), 3rd edition, ed. C.F. Müller, 2015, p. 65, point 649.

20 – In particular, the General Court cited paragraph 56 of that judgment, which states that Directive 2008/95

does not preclude the use of the general indications of the class headings of the Nice Classification to identify the goods and services for which the protection of the trade mark is sought, provided that such identification is sufficiently clear and precise to allow the competent authorities and economic operators to determine the scope of the protection sought.

21 – Paragraph 61 of the judgment in *IP Translator*.

22 – Paragraphs 27 to 34 of the judgment under appeal.

23 – Paragraphs 35 to 38 of the judgment under appeal.

24 – Judgment in *Ansul* (C-40/01, EU:C:2003:145, in particular, paragraphs 40 to 43).

25 – See the previous footnote and also paragraph 44 of the judgment under appeal.

26 – Although the appellant initially made submissions concerning the use of the *Lambretta* trade mark on spare parts by Scooters India, those submissions will not be referred to as they do not appear to be relevant to the resolution of the first ground of appeal.

27 – See paragraph 34 of the judgment under appeal.

28 – Judgment in *Ansul* (C-40/01, EU:C:2003:145, paragraph 37).

29 – *Ibid.*, paragraphs 36 to 42.

30 – Judgment in *Nelson and Others* (C-581/10 and C-629/10; EU:C:2012:657, paragraph 88 and the case-law cited).

31 – Judgments in *Manea* (C-76/14; EU:C:2015:216, paragraph 54 and the case-law cited therein) (rejecting the limitation of temporal effects), and *Borealis Polyolefine and Others* (C-191/14, C-192/14, C-295/14, C-389/14 and C-391/14 to C-393/14; EU:C:2016:311, paragraph 103) (allowing the limitation of temporal effects).

32 – Judgments in *Nelson and Others* (C-581/10 and C-629/10, EU:C:2012:657, paragraphs 90 and 91) and *Meilicke and Others* (C-292/04, EU:C:2007:132, paragraph 37).

33 – More details in paragraphs 22 to 29 of the judgment, which summarise the facts of that dispute.

34 – Paragraph 33 of the judgment states that, on an exceptional and one-off basis, the Registrar departed from his usual practice of adopting the literal approach.

35 – The Chartered Institute of Patent Attorneys.

36 – Paragraphs 38 to 49 of the *IP Translator* judgment.

37 – Paragraphs 50 to 56 of the *IP Translator* judgment.

38 – Paragraphs 57 to 63 of the *IP Translator* judgment.

39 – In the case of EU trade marks, that obligation is contained in Article 26(1)(c) of Regulation No 207/2009 and Rule 2 of the Implementing Regulation. The *IP Translator* judgment interpreted Directive 2008/95, which did not include a similar provision.

40 – It was worded as follows: “Is it necessary or permissible for such use of the general words of the Class Headings of [the Nice Classification] to be interpreted in accordance with Communication No 4/03 ...?”, where the example given in that Communication is that of the all-encompassing approach.

41 – I agree with the assessment of Pohlmann, A., “The Interpretation of the Nice Class headings in the European Union, or the Art of One Hand Clapping”,

The Trademark Reporter, Vol. 15, No 4, INTA, July-August 2015, p. 815 et seq., in particular p. 828.

42 – Paragraph 61 of the judgment.

43 – See, in particular, paragraphs 38 and 42 of the judgment.

44 – Paragraph 45 of the judgment, read in conjunction with paragraphs 43 and 44.

45 – The requirement is found throughout the judgment and is referred to in the context of the second question (where it is imposed in cases where the applicant identifies the goods and services which it seeks to protect by reference to the Classification) and the third question (where applicants are required, in those cases, to specify whether the application covers all or only some of the goods or services included in the alphabetical list of the class designated). See paragraphs 53 and 61, respectively, of the judgment.

46 – Paragraph 47 of the judgment.

47 – Paragraph 55 of the judgment.

48 – Paragraph 60 reads as follows: “... a situation in which the extent of the protection conferred by the trade mark depends on the approach to interpretation adopted by the competent authority and not on the actual intention of the applicant runs the risk of undermining legal certainty both for the applicant and for third party economic operators”.

49 – Judgment in *Agencja Wydawnicza Technopol* (C-51/10 P, EU:C:2011:139, paragraph 77).

50 – Judgment in *Heidelberger Bauchemie* (C-49/02, EU:2004:384, paragraph 29).

51 – Paragraph 27.

52 – See point 6 of this Opinion.

53 – Paragraph 99 of the appeal.

54 – I admit I reached that conclusion after a pro actione reading of the second ground of appeal, the reasoning of which is rather complex, and after questioning the appellant specifically about this point at the hearing.

55 – At the hearing, Brandconcern’s representative accepted that the “procedural error” could be classified as an ultra petita ruling. It is perfectly permissible to claim such an error on appeal; see, for example, the judgment in *Commission v Siemens Österreich and Others and Siemens Transmission & Distribution and Others v Commission* (C-231/11 P to C-233/11 P, EU:C:2014:256, paragraph 115 et seq).

56 – As stated in paragraph 7 of the judgment under appeal.

57 – See, in that connection, the judgment in *Commission and France v TF1* (C-302/99 P and C-308/99 P, EU:C:2001:408, paragraphs 26 to 29).

58 – Judgment in *Ansul* (C-40/01, EU:C:2003:145).

59 – Judgments in *Asteris v Commission* (97/86, EU:C:1988:199, paragraph 27) and *Interporc v Commission* (C-41/00 P, EU:C:2003:125, paragraph 29).

60 – Judgment in *Foyer culturel du Sart-Tilman v Commission* (C-199/91, EU:C:1993:205, paragraph 17).

61 – See the judgment in *Spain v Commission* (C-415/96, EU:C:1998:533, paragraphs 31 and 32 and the case-law cited).